

## REMARKS

This Response is timely filed within three months of the mailing date of the latest Office Action. Accordingly, no fee is required. 37 CFR § 1.134-1.136.

Claims 1-19, and 21-32 are pending in this application, and Claim 28 is withdrawn. Claims 1, 6, 29, and 30 are amended. No new matter has been added. Reconsideration of the claim rejections in view of the following remarks is respectfully requested.

### **I. The Claims Are Not Anticipated by Preissman or Chin**

The Office rejected Claims 1-5, 10-12, 15-16, 21-25, and 29-32 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,383,190 to Preissman (hereinafter "Preissman"). The Office also rejects Claims 21 and 26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,156,606 to Chin (hereinafter "Chin"). Applicant respectfully traverses these rejections.

Preissman does not disclose the claimed subject matter of the present application. Although Preissman discloses a pressure applicator for delivering an implant material, Preissman fails to teach every feature of the claimed invention. With respect to Claims 1, 21, 29 and 30, Preissman does not disclose a hollow tube that is removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly. First, The Examiner cites hollow tube 152 as abutting with the dispenser hub; however, Preissman fails to disclose any type of connection other than touching between the dispenser hub assembly and the hollow tube. Abutting or touching is not "attached" as required by Claims 1, 21, 29, and 30. Second, the hollow

tube 152 cannot be removed unless column 96 is removed entirely from the apparatus because the pressure from column 96 is necessary to hold hollow tube 152 in place. Therefore, Preissman does not disclose a hollow tube that is removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly.

The Office rejected Claims 21 and 26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,156,606 to Chin. Applicant respectfully traverses these rejections.

Chin does not disclose a tube that is removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly. The cement cartridge 12 is described in the specification as secured to the injection gun 10. See Chin Col. 3, ll. 34-35. The specification in Chin is silent on whether or not the cement cartridge 12 is removable. The issue is not addressed in the specification, but more importantly, the specification does not suggest or teach a need for the cartridge to be removable. The only language used regarding the cartridge is that it is secured to the injection gun. Even if the cement cartridge 12 is removable, the design has the exact same problem that is described above in Preissman. The cement cartridge 12 could only be inserted when the plunger (not numbered) is removed. The cement cartridge 12 is not attached to the injection gun 10. The cement cartridge 12 is only secured by the pressure of the shaft and can only be removed when the shaft is removed.

For at least these reasons, Applicant respectfully submits that Preissman and Chin fail to disclose Applicant's claimed invention. Accordingly, Applicant requests reconsideration and withdrawal of the rejections.

## **II. The Claims are Non-Obvious**

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Preissman in view of U.S. Patent No. 6,352,585 to Diesso (hereinafter "Diesso"). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Preissman in view of U.S. Patent No. 5,603,701 to Fischer (hereinafter "Fischer"). Claims 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,395,007 to Bhatnagar et al. (hereinafter "Bhatnagar") in view of Preissman. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,156,606 to Chin. Applicant respectfully traverses these rejections.

In order to establish a *prima facie* showing of obviousness under Section 103, the Examiner must set forth three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. See MPEP §§ 706.02(j), 2142 (8th ed., 2nd Rev., 2004). Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or the references when combined must teach or suggest all of the claim limitations. *Id.*

The only apparent motivation for combining the references above arises from Applicant's disclosure and the claimed invention itself, which constitutes impermissible

hindsight motivation and cannot be relied upon as a reason to combine references. See, e.g., *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

With respect to Claim 21, taken alone or in combination, neither Bhatnagar nor Preissman teach or suggest the claimed subject matter. Although Preissman discloses a pressure applicator for delivering an implant material, Preissman fails to teach every feature of the claimed invention as disclosed above. Preissman does not disclose a hollow tube that is removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly. Moreover, Preissman is silent as to the use of a multi-use kit for delivery of bone cement. Although Bhatnagar teaches the use of a kit including an injection device, Bhatnagar also fails to teach the elements of the claimed invention, including a hollow tube filled with bone cement that removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly. The Examiner states that Bhatnagar discloses “a tubing assembly removably attached to the cement delivery means”. This assertion is insufficient to render the claimed subject matter obvious. Bhatnagar fails to teach either a dispenser hub assembly or a hollow tube filled with bone cement that is removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly. It is well established that a prior art reference or combination of references must teach or suggest all of the claim limitations. Accordingly, Preissman and Bhatnagar fail to establish a *prima facie* showing of obviousness because neither reference teaches a hollow tube filled with bone cement that is removably attached to the dispenser hub assembly when the shaft is attached to the dispenser hub assembly. The tubing

described in Bhatnagar is neither filled with bone cement nor attached to the dispenser hub assembly. The examiner suggests that the elements in Bhatnagar are functional equivalents of the elements in Preissman. However, the tubing assembly 44 is not a function equivalent of the hollow tube 152 in Preissmen and would not work if it was substituted. These two elements are performing different functions. Therefore, the combination of these two references fails to teach the claimed subject matter because neither reference teaches the claimed element.

Claims dependent on nonobvious independent claims are nonobvious themselves. See *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988). Dependent Claims 2-5, 10-16, and 22-27 depend from, and thus incorporate the features recited in independent Claim 1 or 21, as well as additional limitations which render the claims patentable.

In view of the foregoing, Applicant submits that the cited references do not teach or suggest the claimed subject matter and respectfully requests withdrawal of the rejections of the Claims under Section 103.

### III. Conclusion

Applicant respectfully submits that the Claims of the present invention define patentable subject matter and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the below listed telephone number.

It is believed that no fee is required for the present amendment. In the event that a fee is required, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to deposit account number 03-2469. Moreover, if the deposit account contains insufficient funds, the Commissioner is hereby invited to contact Applicant's undersigned representative to arrange payment.

Respectfully submitted,



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